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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			MEINECKE DIAZ, SUSANNA M	
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			3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/996,341	Applicant(s) SNYDER, CECILY ANNE	
	Examiner Susanna M. Diaz	Art Unit 3623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This final Office action is responsive to Applicant's amendment filed July 18, 2006.

Claims 1, 11, 12, 16, and 17 have been amended.

Claim 4 has been cancelled.

Claims 21-26 have been added.

Claims 1-3 and 5-26 are presented for examination.

### ***Response to Arguments***

2. Applicant's arguments filed July 18, 2006 have been fully considered but they are not persuasive.

Applicant argues that "Kamarei fails to teach a case data unit that stores one or more documents related to an intellectual property case. Instead, Kamarei merely teaches the storage of docketing information, along with triggering associated reminders and deadlines." (Pages 10-11 of Applicant's response) The Examiner respectfully disagrees. Kamarei specifically states that "the Governmental System appends an electronic document, in ASCII, Word Perfect, MS Word, GIF, JPG, PDF, or any other type of format to the Docket Request Message." (Col. 10, lines 64-67) Furthermore, various documents may be generated in relation to a case (col. 11, lines 40-67; col. 13, lines 55-63). The docket request messages are case specific, have related documents, and are managed as a case data unit by a case management system (as seen in Fig.

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6); therefore, Kamarei's case data unit stores data related to the intellectual property case and one or more documents related to the first intellectual property case.

Also, Examiner notes that, as per MPEP § 2144.03(C), the statements of Official Notice made in the art rejection have been established as admitted prior art since Applicant has not traversed the Examiner's assertions of Official Notice. More specifically, the following statements of Official Notice are now formally established on record as admitted prior art:

Official Notice is taken that it is old and well-known in the art of intellectual property to prosecute copyright cases.

Newly added claims 21-26 will be addressed in more detail in the art rejection below.

In summary, Applicant's arguments are not persuasive.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, and 5-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamarei et al. (U.S. Patent No. 6,859,806).

Kamarei discloses a computer-implemented method of generating a message for a first intellectual property case, the method comprising:

[Claim 1] storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case (col. 5, lines 19-31 – Docketed cases are related to cases filed with a governmental office, such as a patent or trademark office; col. 6, line 49 – Case Listing Database; col. 10, lines 6-10 – Cases can be searched for and retrieved from a Case Listing Database, which implies that there are a plurality of cases stored), wherein storing information related to the first intellectual property case comprises storing the information related to the first intellectual property case in a case data unit, wherein the case data unit stores data related to the intellectual property case and one or more documents related to the first intellectual property case (Fig. 6; col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9; Kamarei specifically states that “the Governmental System appends an electronic document, in ASCII, Word Perfect, MS Word, GIF, JPG, PDF, or any other type of format to the Docket Request Message.” (Col. 10, lines 64-67) Furthermore, various documents may be generated in relation to a case (col. 11, lines 40-67; col. 13, lines 55-63). The docket request messages are case specific, have related documents, and are managed as a case data unit by a case management system (as seen in Fig. 6); therefore, Kamarei’s case data unit stores data related to the intellectual property case and one or more documents related to the first intellectual property case);

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receiving a signal indicating occurrence of an event related to the first intellectual property case (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

responsive to receiving the signal, identifying one or more rules associated with the event (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

identifying at least a first rule from the one or more rules based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

generating at least one message using the at least first rule, the message identifying an action to be performed in response to the event and identifying a date associated with the action (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9); and

communicating the at least one message to a first designated client system (col. 9, line 64 through col. 10, line 2);

[Claim 2] wherein the plurality of intellectual property cases includes patent cases and the first intellectual property case is a patent application case (col. 9, lines 6-10 – The case may be related to patent prosecution);

[Claim 5] wherein the signal indicating occurrence of the event related to the first intellectual property case is generated responsive to a change in the information related to the first intellectual property case (col. 12, lines 1-34);

[Claim 6] wherein identifying the at least first rule from the one or more rules based upon the filter criteria information comprises:

determining a set of rules from the one or more rules associated with the event, wherein a rule from the one or more rules is included in the set of rules if the filter criteria associated with the rule is satisfied by the information related to the first intellectual property case, the set of rules including the at least first rule (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 7] wherein the plurality of intellectual property cases includes patent cases and the first intellectual property case is a patent application case; and

the filter criteria associated with each rule in the one or more rules comprises a criterion related to filing status of a patent case, a criterion related to a type of the patent case, and a criterion related to priority information for a patent case (Fig. 6; col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 8] wherein generating the at least one message using the at least first rule comprises:

determining an action associated with the at least first rule (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

determining a date generation formula associated with the action and a base date used by the date generation formula (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

applying the date generation formula to the base data to generate the date associated with the action (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9); and

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including information indicating the action associated with the at least first rule and the date generated by applying the date generation formula in the at least one message (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 9] wherein communicating the at least one message to the first designated client system comprises:

determining one or more users associated with the first intellectual property case from information related to the first intellectual property case (col. 9, line 64 through col. 10, line 2);

from the one or more users, determining a first user who is designated to receive the at least one message generated using the first rule (col. 9, line 64 through col. 10, line 2);

communicating the at least one message to a system used by the first user (col. 9, line 64 through col. 10, line 2);

[Claim 10] wherein communicating the at least one message to the system used by the first user comprises:

sending an electronic mail message to first user, the electronic mail message including the at least one message (col. 9, line 64 through col. 10, line 2).

[Claims 11-20] Claims 11-20 recite limitations already addressed by the rejection of claims 1, 2, 4, 6, 8, and 9 above; therefore, the same rejection applies.

It should be noted that Kamarei uses a processor and memory to perform the recited functionality (col. 5, lines 19-31; col. 5, line 41; col. 6, lines 38-57).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamarei et al. (U.S. Patent No. 6,859,806), as applied to claim 1 above.

[Claim 3] Kamarei teaches that the plurality of intellectual property cases includes trademark cases (col. 9, lines 6-10), yet Kamarei does not expressly teach that the cases may be copyright cases. However, Official Notice is taken that it is old and well-known in the art of intellectual property to prosecute copyright cases. Kamarei is open to managing various types of transactions with governmental systems (col. 5, lines 26-28) and copyrights are obtained through a government office, such as the U.S. Copyright Office; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Kamarei to assist in the management of copyright dockets in order to expand the marketability of Kamarei's invention, thereby increasing the likelihood for profit.

7. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamarei et al. (U.S. Patent No. 6,859,806), as applied to claim 1 above, in view of Lee (U.S. Patent No. 7,016,852).

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[Claim 21] While Kamarei stores case-related documents (as discussed above), Kamarei does not expressly teach that the one or more documents comprise one or more documents selected from the group consisting of: an invention disclosure, a filed patent application, a patent drawing, an old version of a patent application, an office action, and a response to an office action; however, the differences in the types of documents are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Nevertheless, Lee discloses a docket management system that formats and stores documents (e.g., documents to be filed with an intellectual property office, such as the specification, claims, abstract, and drawings of a patent application) (col. 7, lines 1-5, 18-67). Both Kamarei and Lee are directed toward intellectual property docket management systems; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Kamarei such that the one or more documents comprise one or more documents selected from the group consisting of: an invention disclosure, a filed patent application, a patent drawing, an old version of a

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patent application, an office action, and a response to an office action in order to facilitate more efficient and rapid collaboration among various parties in an effort to transact with an intellectual property office (which is a general goal of both Kamarei, as seen in col. 4, lines 39-54, and Lee, as seen in col. 3, lines 17-64).

Regarding claims 22 and 23, Kamarei does not expressly teach the steps of storing the one or more documents comprising storing each document as part of a document entity that comprises the document and a set of meta-data about the document (claim 22), wherein the set of meta-data about the document comprises one or more data elements selected from the group consisting of a document ID, a document type, an originator, a status, a security profile, a file format, a creation date, a last modified date, a set of physical file attributes, a set of search field key words, a completion date, and a list of witness names (claim 23) and scanning a paper to produce a scanned document in a computer readable format, wherein storing one or more documents comprises storing the scanned document (claim 24). However, Lee discloses that the documents may be scanned (col. 11, lines 18-21; col. 13, lines 4-7) and stored in a format that defines the document's meta-data corresponding to the document's physical file attributes and file format (col. 12, lines 12-36). Again, both Kamarei and Lee are directed toward intellectual property docket management systems; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Kamarei to perform the steps of storing the one or more documents comprising storing each document as part of a document entity that comprises the document and a set of meta-data about the

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document (claim 22), wherein the set of meta-data about the document comprises one or more data elements selected from the group consisting of a document ID, a document type, an originator, a status, a security profile, a file format, a creation date, a last modified date, a set of physical file attributes, a set of search field key words, a completion date, and a list of witness names (claim 23) and scanning a paper to produce a scanned document in a computer readable format, wherein storing one or more documents comprises storing the scanned document (claim 24) in order to facilitate more efficient and rapid collaboration among various parties in an effort to transact with an intellectual property office (which is a general goal of both Kamarei, as seen in col. 4, lines 39-54, and Lee, as seen in col. 3, lines 17-64). Also, Lee implies that scanning documents facilitates the collaborative approval of documentation and submission thereof to an appropriate intellectual property office (col. 11, lines 7-21; col. 13, lines 2-21), which would be advantageous to Kamarei's intellectual property docket management system for the same reasons since both Lee and Kamarai are ultimately concerned with the goal of efficiently and quickly performing transactions with an intellectual property office.

Additionally, as per claim 25, neither Kamarei nor Lee expressly teaches the step of subjecting the scanned document to optical character recognition to recognize data from one or more fields from the scanned document, wherein storing the data related to the intellectual property case comprises storing the recognized data in the case data unit; however, Official Notice is taken that it is old and well-known in the art of document scanning to scan documents using optical character recognition. The use of optical

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character recognition allows one to more easily extract a desired subset of data from the scanned document. Since the Kamarei-Lee combination addresses the storage and scanning of intellectual property related documents, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the Kamarei-Lee combination to perform the step of subjecting the scanned document to optical character recognition to recognize data from one or more fields from the scanned document, wherein storing the data related to the intellectual property case comprises storing the recognized data in the case data unit in order to allow one to more easily extract a desired subset of data from the scanned document, which can be especially useful when filing patent applications and related documents electronically.

Regarding claim 26, Kamarei teaches the step of receiving a signal indicating occurrence of an event related to the first intellectual property case (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9), yet Kamarei does not expressly teach that the signal indicating occurrence of the event related to the first intellectual property case is generated responsive to the recognized data. However, Kamarei's event reminders may be related to events that require the filing of a document (as seen from the types of actions shown in Fig. 8). If a reminder to file a document is generated (as seen in Kamarei) and documents needed to pursue patent prosecution are scanned (as seen in the Kamarei-Lee combination), the Examiner submits that the scanning of required documents would obviously allow one to respond to the types of actions shown in Fig. 8 of Kamarei. For example, if an affidavit is due, this implies that a document containing an affidavit needs to be filed. Therefore, the

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Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to further modify the Kamarei-Lee combination such that the signal indicating occurrence of the event related to the first intellectual property case is generated responsive to the recognized data in order to more efficiently provide reminders to file required documents related to an event reminder when these documents become available.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

August 2, 2006